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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/776,714	02/06/2001	Gary M. Katz	PIP-69A-KATZ	2896
31518	7590	05/14/2010	EXAMINER	
NEIFELD IP LAW, PC 4813-B EISENHOWER AVENUE ALEXANDRIA, VA 22304				ALVAREZ, RAQUEL
ART UNIT		PAPER NUMBER		
		3688		
NOTIFICATION DATE			DELIVERY MODE	
05/14/2010			ELECTRONIC	

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

general@neifeld.com  
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<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	09/776,714	KATZ, GARY M.	
	<b>Examiner</b>	<b>Art Unit</b>	
	Raquel Alvarez	3688	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

1) Responsive to communication(s) filed on 2/26/2010.

2a) This action is **FINAL**.                    2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

4) Claim(s) 66-88 is/are pending in the application.

4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

5) Claim(s) \_\_\_\_\_ is/are allowed.

6) Claim(s) 66-88 is/are rejected.

7) Claim(s) \_\_\_\_\_ is/are objected to.

8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) All    b) Some \* c) None of:

1. Certified copies of the priority documents have been received.
2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)	4) <input type="checkbox"/> Interview Summary (PTO-413)
2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)	Paper No(s)/Mail Date. _____ .
3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date <u>2/2/2010</u> .	5) <input type="checkbox"/> Notice of Informal Patent Application
	6) <input type="checkbox"/> Other: _____ .

## DETAILED ACTION

1. This office action is in response to communication filed on 2/26/2010.
2. Claims 1-65 have been cancelled. Claims 66-88 are newly added and presented for examination.

### **Claim Rejections - 35 USC § 102**

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. Claims 66, 68-75, 77-81, 85-88 are rejected under 35 U.S.C. 102(e) as being anticipated by Barnett et al.(6,336,099 hereinafter Barnett).

With respect to claims 66, 72, 74-75, 81, 86 Barnett teaches a computer-implemented method:

receiving, using an identification input device designed to receive identification information, a first consumer identification for a first consumer (i.e. receiving first consumer identification using personal computer 6)(Figure 1);

identifying, using a processor, promotions offered to said first consumer, by retrieving from a central database system in which consumer identifications are associated with promotion offers data for promotions previously offered to consumers, first consumer promotions offer data associated with said first consumer identification

for promotions previously offered to said first consumer (i.e. coupon distributor 16 and coupon issuer 14 maintaining information on redemption information on previous promotions issued to the first consumer/users)(see Figure 1);

determining, using said processor, and based at least in part upon said first consumer promotions offer data, a first consumer demographic characteristic of said first consumer (i.e. providing demographic data characteristic for the first consumer/user)See Figure 9);

determining, using said processor, and based at least in part upon said first consumer demographic characteristic, a time at which to transmit to said first consumer a subsequent promotion offer (i.e. using consumer demographic characteristics to determine and analyzing a time period of when to issue subsequent coupon package/sets)(see Figures 9-10).

With respect to claims 87 and 88 in addition to the limitations addressed above in claims 66, 75, Barnett further teaches a central database comprising a consumer identification table and a promotion table (see Figure 2).

With respect to claims 68-69, 77-78 Barnett further teaches wherein said time is also based upon the purchase history of said consumer and redemption history (i.e. redemption information).

With respect to claims 70-71, 79-80 Barnett further teaches wherein said subsequent promotions is delivered to an Internet protocol address associated with said first consumer (i.e. user's e-mail address)(col. 13., lines 60-65).

With respect to claims 73, 85 Barnett further teaches wherein said time is also based upon the value of said subsequent promotion offer (col. 13, lines 30-41).

**Claim Rejections - 35 USC § 103**

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

6. Claims 67, 76, 82-84 are rejected under 35 U.S.C. 103(a) as being unpatentable over Barnett.

Claims 67, 76, 82 further recite the time based upon the desirability of the consumer to a promoter during a particular time period. Official notice is taken that it is old and well known for promoters, advertisers and the like to account for how valuable or profitable a consumer is in order to time promotions accordingly. For example, a consumer that makes more purchases will receive offers more often than a consumer that doesn't redeem their offers in order to time offers accordingly. It would have been obvious to a person of ordinary skill in the art at the time of Applicant's invention to have

included promotion offers time based upon the desirability of the consumer to a promoter in a particular time period in order to obtain the above mentioned advantage.

Claims 83-84 further recite the time of the offer being based upon a retail store providing the desired number of promotions during a particular time period and the desirability of said first consumer to a retail store. Official Notice is taken that it is old and well known for retailers store and the like to issue coupons during a particular time period and for retailers to account for how valuable or profitable a consumer is in order to time promotions accordingly. For example, consumer that makes more purchases will receive offers more often from a retailer than a consumer that doesn't redeem their offers in order to time offers accordingly. It would have been obvious to a person of ordinary skill in the art at the time of Applicant's invention to have included the time of the offer being based upon a retail store providing the desired number of promotions during a particular time period and the desirability of said first consumer to a retail store in order to obtain the above mentioned advantage.

**Response to Arguments**

7. Applicant's arguments with respect to claims 66-88 have been considered but are moot in view of the new ground(s) of rejection.

**Conclusion**

8. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

**Point of contact**

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Raquel Alvarez whose telephone number is (571)272-6715. The examiner can normally be reached on 9:00-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Lynda Jasmin can be reached on (571)272-6782. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Raquel Alvarez/  
Primary Examiner, Art Unit 3688

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Primary Examiner  
Art Unit 3688

R.A.  
4/23/2010